



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,686	10/16/2001	Joseph R. Nardone	003636.0125	3773

7590 08/24/2007
William H. Bollman
Manelli Denison & Selter PLLC
2000 M Street, N.W.
Suite 700
Washington, DC 20036

EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
----------	--------------

2152

MAIL DATE	DELIVERY MODE
-----------	---------------

08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/977,686

Applicant(s)

NARDONE ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1> This action is in response to Applicant's amendment and arguments, filed 6.5.2007.

Claims 1, 15, 20, 21, 26 and 27 are amended. Claims 1-31 are presented for further examination.

2> This is a final rejection.

Response to Arguments

3> Applicant argues that Alam and Feague disclose a system that synchronizes a client and a host computer upon connection of the devices. Applicant argues that this is contrary to Applicant's claimed invention because it is "NOT synchronization executed from a SYNCHRONIZATION INSTRUCTION in a RUNNING application on a personal data assistant" (emphasis in original) Applicant's arguments, pg. 11, ¶2. Applicant has amended independent claims 1, 20, 21, 26 and 27 to include this functionality. However, Alam and Feague disclose the amended limitations.

It should first be noted that the claims do not define or further limit what Applicant means by "synchronization instruction." Alam discloses an application running on said personal data assistant [Figure 1 «item 12» | Figure 6 «item 26»], whereby the application executes a synchronization instruction [column 7 «lines 44-46 and 58-67» where : the PIM and applications execute DLLs (analogous to Applicant's synchronization instruction) as the DLLs enable synchronization between the PDA and host device]. Alam's applications are always running on the PDA.

As another interpretation, Alam discloses that applications running on a personal data assistant to execute synchronization functions and methods that allow the applications to perform synchronization related activities [column 10 «lines 1-8» | column 12 «lines 34-63»]. These methods are analogous to Applicant's claimed "synchronization instructions" in that they are executed by the application while running on the personal data assistant. The point being that there is nothing in Applicant's claims that proscribe the interpretations of "synchronization instruction" set forth in the non-final rejection, filed 12.6.2006 and in this instant action. Examiner suggests amending the claim to further clarify the functionality or scope of the term "synchronization instruction" which would help in overcoming the Alam and Feague references.

In contrast to the other independent claims, claim 15 discloses that the synchronization instruction is executed for synchronizing a first and second database. However, Examiner submits that Alam still can be interpreted to read on this limitation. For example, the synchronization methods called by the Alam's manager help to synchronize data between two lists, each list reflecting a different data store [Figure 1 «items 20, 22» | column 11 «lines 50-61» | column 12 «lines 34-40»].

It is also noted that Applicant is arguing limitations not in the claims. Applicant argues that the proposed combination of Alam and Feague is "NOT synchronization executed from a SYNCHRONIZATION INSTRUCTION in a RUNNING." However, the claim does not state that *synchronization* is executed from a synchronization instruction, merely that an application running on the personal data assistant executes a synchronization

Art Unit: 2152

instruction. As discussed above, the claim does not describe or define what Applicant means by synchronization instruction.

According to Applicant's claim, synchronization is automatically initiated between said personal data assistant and a host device by the personal data assistant that is executing the instruction. But nothing in the claims specifies that the synchronization is initiated based on or because of the executed synchronization instruction. Again, the claims would benefit from new language that would clarify what Applicant views as the invention and to better reflect the functionality described by Applicant's specification.

However, as the claims are currently written and based on the foregoing remarks with respect to Examiner's interpretation of "synchronization instruction, Examiner submits that Alam and Feague disclose the limitations in their current form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4> Only those claims that have been amended by Applicant are formally addressed in this action. For the substance of the rejections for those claims not addressed in this action, see the non-final Office action, filed 12.6.2006, hereby incorporated by reference.

Art Unit: 2152

5> Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam et al. (U.S. Patent Number 6,324,544), hereinafter referred to as Alam, in view of Feague (U.S. Patent Number 6,247,135).

6> Alam disclosed a method for synchronizing file objects in object stores between a mobile device and a host computer. In an analogous art, Feague disclosed a method for synchronization process negotiation between a client and a host computer on which data are to be synchronized.

7> Concerning claims 1, 15, 20, 21, 26, and 27, Alam did not explicitly state the synchronization being automatically initiated between the personal data assistant and the host device by the personal data assistant executing the synchronization instruction. Although Alam refers to synchronizing objects upon connection of the devices, he is not specific on this aspect and so is not explicit about "automatically synchronizing." However, Feague discloses this feature as his system begins synchronization upon connection of the devices by allowing them to automatically exchange acknowledgments and begin a synchronization negotiation. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Alam by adding the ability to automatically initiate synchronization between the personal data assistant and the host device by the personal data assistant executing the synchronization instruction as provided by Feague. Here the combination satisfies the need for synchronization methods that

Art Unit: 2152

support a generalized synchronization protocol while still adapting to the capabilities of the devices. See Feague, column 3, lines 47-56.

8> Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as an apparatus are rejected under the same rationale applied to the described claim.

9> Thereby, the combination of Alam and Feague discloses:

- <Claim 1>

A method of reconciling data between a host device wirelessly connected to a personal data assistant, comprising: commencing execution of an application on said personal data assistant (Alam, column 10, lines 44-52); executing, while said application is running on said personal data assistant, a synchronization instruction from said application (Alam, Figure 1 | column 10, lines 53-62 and column 12, lines 15-63 where the manager application runs on the personal data assistant and executes methods to perform synchronization); and synchronizing data over a wireless connection stored in said personal data assistant with data stored in said host device (Alam, column 13, lines 6-17 and column 5, lines 36-52); wherein synchronization is automatically initiated between said personal data assistant and said host device by said personal data assistant executing said synchronization instruction (Feague, column 14, lines 45-67).

- <Claim 15>

A system comprising: a personal data assistant comprising at least one first database (Alam, figure 1, items 12, 20, and 22); and a host device adapted to be connected to said personal data assistant over a wireless connection and including at least one second database (Alam, figure 1, items 14, 32, and 34 and column 5, lines 36-52); wherein said personal data assistant is adapted to be configured to execute a synchronization instruction for synchronizing said at least one first database and said at least one second database, said synchronization instruction is adapted to be executed from an application running on said personal data assistant (Alam, column 10, lines 53-62; column 12, lines 34-40; column 13, lines 6-17; Figure 1 «items 20, 22»; column 11 «lines 50-61»); and wherein synchronization is automatically initiated between said personal data assistant and said host device by said personal data assistant executing said synchronization instruction (Feague, column 14, lines 45-67).

- <Claim 20>

A data synchronization system comprising: a host computer including an integrated design environment (Alam, figure 1, item 14), a first plurality of databases (Alam, figure 1, items 32 and 34), and at least one application (Alam, figure 1, item 30), wherein said host computer is configured to generate said at least one application and a program file including instructions executed with said application (Alam, column 5, lines 28-34); and a personal data assistant connected to said host computer through a wireless connection (Alam, figure 1, item 12 and column 5, lines 36-52), said personal data assistant comprising a runtime engine (Alam, figure 1, item 24) and a second

Art Unit: 2152

plurality of databases (Alam, figure 1, items 20 and 22); wherein said personal data assistant is configured to receive said at least one application and program file from said host computer (Alam, column 5, lines 28-52), and said runtime engine is configured to initiate said at least one application and a synchronization instruction in said program file for synchronizing at least one database in said second plurality of databases with at least one associated database from said first plurality of databases (Alam, column 10, lines 53-62; column 12, lines 15-26; and column 13, lines 6-17 and Feague, column 14, lines 45-67); and wherein synchronization is automatically initiated between said personal data assistant and said host computer (Feague, column 14, lines 45-67) by said personal data assistant executing said synchronization instruction, while said at least one application is running on said personal data assistant (column 7 «lines 44-46 and 58-67», column 12 «lines 34-63»).

- <Claims 21, 26, and 27>

A method of synchronizing data between a personal data assistant and a remote computer, comprising: selecting from said personal data assistant which files on said personal data assistant to synchronize with said remote computer (Alam, column 12, line 48 through column 13, line 5); establishing wireless communications between said personal data assistant and said remote computer (Alam, column 10, lines 53-62; column 12, lines 15-26; and column 5, lines 36-52); running an application on said personal data assistant (Alam, Figure 1 «items 24, 16, 18» | Figure 6 «items 140, 144, 146»); and while said application is running on said personal data assistant (Alam, Figure 1 where : the synchronization applications are always running on the PDA),

Art Unit: 2152

automatically synchronizing data between said personal data assistant and said remote computer (Alam, column 13, lines 6-17 and Feague, column 14, lines 45-67).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

8/19/7